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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,130	12/18/2001	Zhiming Zhou	56008US002	5126

32692 7590 11/03/2004

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	10/025,130	ZHOU ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 to 11, 13 to 22, 25, 28, 29 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 to 32 is/are allowed.
- 6) ☒ Claim(s) 2 to 11, 13 to 22, 25, 28, 29 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1712

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 2 - 6, 8 - 11, 13, 14, 16 - 22, 25, 29 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Leir.
3. Claims 7, 15, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leir.
4. The teachings of Leir have been addressed in the previous office actions and the instant rejections rely on the rationale noted in the previous office actions. As such this will not be repeated. Since applicants rely on limitations added to the independent claims to overcome these rejections and they do not provide separate arguments for the anticipation and obviousness rejections, the rejections will be addressed together.

Independent claims 11 and 13 have been amended to recite that the priming composition is capable of adhering to a substrate comprising acid functional groups. Applicants argue that Leir does not teach or suggest that such compositions are capable of adhering to a substrate comprising acid functional groups. They note that the composition in Leir requires a certain minimum ionic content and that ionic groups interfere with the adherence of priming and PSA compositions to substrates comprising acid functional groups.

However the Examiner does not agree that the composition in Leir is not capable of adhering to a substrate comprising acid functional groups. Note for instance that Leir coats PET (polyester) surfaces. Such surfaces would be expected to inherently possess at least some acidic functional groups as a result of the monomers used to prepare PET. Also, Leir teaches that the ionic content should be kept at a minimum because ionic groups negatively affects polymer properties (page 7, line 20). Since the polymers in Leir are intended to be used as adhesives the skilled artisan would recognize that the ionic content therein would not be present in such an amount that it would negatively affect or destroy the desired adhesive properties.

Art Unit: 1712

The phrase "capable of adhering to a substrate comprising acid functional groups" does not require a degree or level of adherence; thus, *any* degree of adherence would meet this limitation. In other words, the only way this language would distinguish the claims from the prior art is if the prior art composition had absolutely no adhesion and was not even *capable* of adhering to substrates with acid functional groups. Since Leir specifically teaches that the prior art composition can be used as an adhesive and provides no indication that certain substrates are inoperable, it follows then that the prior art composition would at least be capable of adhering to a substrate comprising acid functional groups.

On the other hand, the applicants state (with no supporting evidence) that ionic groups "interfere" with the adherence of priming and pressure sensitive adhesive compositions. However, interference does not mean that the compositions are not capable of adhering. This general statement fails to provide clear and convincing evidence of novelty. As such the amended claims fail to distinguish themselves from the prior art.

Claims 25 and 33 require that the surface comprise acid functional groups. As noted supra, PET would be expected to possess at least some residual acid groups, thereby meeting this limitation.


5. Claims 30 to 32 are allowed for reasons of record.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
11/1/04